

REMARKS

This amendment responds to the Office Action mailed on July 24, 2008, the statutorily shortened period of which expires on October 24, 2008. Applicants respectfully submit that this response is being filed within three (3) months of the mailing of the Office Action.

The Specification has been amended to correct obvious typographical errors. Accordingly, no new matter has been entered.

Claims 19, 20 and 22-24 are pending and have been rejected. Applicants traverse these rejections and respectfully request reconsideration and allowance of all the pending claims based on the following remarks.

Claim Rejections - 35 U.S.C. § 103**I. 35 U.S.C. 103(a) Rejection of Claims 19-20 & 22-24: Naylor & IBM**

Claims 19-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Naylor et al. US Patent 6,625,642 in view of an IBM Corporation product Facsimile Support/400 hereinafter known as IBM. (Pg. 3, Office Action). This rejection is respectfully traversed.

Independent Claim 19 recites, in pertinent part:

19. An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

receiving from a client computer an electronic business transaction document that is compatible with a business management software program ... the electronic business transaction document including address information and a preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the address information and the preferred communication format being automatically retrieved from an electronic address book stored at the client computer ...

(emphasis added).

A. Naylor

Naylor in view of IBM fails to teach, suggest or disclose a “preferred communication format indicator being automatically retrieved from an electronic address book stored at the client computer” as recited by Claim 19.

Rather, Naylor actually teaches away from a “preferred communication format indicator being automatically retrieved from an electronic address book stored at the client computer” of Claim 19, as Naylor specifically teaches:

As shown in FIG. 3, a user wishing to transmit a document to the server to have it forwarded via fax or email, would place the document in the fax device scanner (step 300) and enter one or multiple destination identifiers into the fax device keyboard (step 302). The destination identifier(s) would either take the form of a phone number, or an email address, or both, depending on where and how the sender wishes the document to go. The email addresses or fax numbers could also have been entered beforehand and stored in a memory location in the memory of the fax device. In such a case the user would select the memory location via a method appropriate to the fax device in order to designate the email addresses or fax numbers contained therein.

(Naylor, Col. 9:57 to Col. 10:3) (emphasis added).

Therefore, as shown from above, a user must manually “enter one or multiple destination identifiers into the fax device keyboard” or the user must manually “select the memory location via a method appropriate to the fax device in order to designate the email addresses or fax numbers contained therein”. This is the exact opposite of having a “preferred communication format indicator being automatically retrieved from an electronic address book stored at the client computer” as recited by Claim 19.

Naylor further teaches:

Alternatively, the server may contain one or more memory locations containing listings of email addresses or fax telephone numbers, such as for example in the form of a mailing list. In such a case, the sending fax device can elect to send emails or faxes to recipients stored in such a server repository. This would be accomplished by providing an indicator in the fax transmission which designates the appropriate memory location for the desired listing resident in the server, rather than or in addition to the aforementioned email addresses or fax numbers.

(Naylor, Col. 10:3-13) (emphasis added).

Again, this portion of Naylor shows that the user must manually provide "an indicator in the fax transmission" rather than, or in addition to, manually providing the "aforementioned email addresses or fax numbers" shown above (Naylor, Col. 9:57 – Col. 10:3) to use listings of email addresses or fax telephone numbers. This clearly teaches away from a "preferred communication format indicator being automatically retrieved from an electronic address book" as recited by Claim 19.

B. IBM

Independent Claim 19 recites, in pertinent part:

19. An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

receiving from a client computer an electronic business transaction document ... including a [1] preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the address information and the preferred communication format [2] being automatically retrieved from [3] an electronic address book stored at the client computer ...

(emphasis added).

1. “preferred communication format indicator for each ... recipient”

First, IBM fails to teach, suggest or disclose “a preferred communication format indicator for each of the plurality of recipient parties of the business transaction” as recited by Claim 19. The Examiner admits on Page 7, Second Paragraph of the Office Action that: “IBM does not explicitly teach preferred communication format indicator for each of the plurality of recipient parties of the business transaction.” IBM teaches that all communications must occur according to the “CCITT Group 3” fax format (IBM, Pg. 2) and that the “Facsimile Support/400 product send process” must “[c]onvert the cover page and spooled file [the rest of the pages] to the Group 3 fax format” (IBM, Pg. 4-5). Therefore, since all communications sent to recipients by the IBM device occur according to the “industry standard” “CCITT Group 3” fax format (IBM, Pg. 2), IBM actually teaches away from multiple, different “preferred communication formats” for each “of the plurality of recipient parties of the business transaction” as recited by Claim 19.

2. “preferred communication format indicator being automatically retrieved”

Second, the Examiner states on Page 2 of the Office Action that “In IBM, [a] computer that generates documents can embed [the] address of one or more recipient(s). IBM teaches [the] capability to send a fax to a previously defined destination or a fax distribution list [IBM, page 4].” Applicants respectfully submit that the Examiner is mistaken as to his interpretation of IBM.

IBM still fails to teach, suggest or disclose a “preferred communication format indicator being automatically retrieved from an electronic address book stored at the client computer” as recited by Claim 19. As a matter of fact, IBM teaches away from this above recited limitation of Claim 19. As can be seen on Pages 105-111 of IBM (“Using the Submit Fax Window”), a user must manually enter telephone number data and recipient data into the various fields. Therefore, IBM necessarily fails to teach, suggest or disclose any feature that enables a “preferred communication format indicator [to be] automatically retrieved from an electronic address book stored at the client computer” as recited by Claim 19.

3. "electronic address book"

Third, the "SBMFAX command" (Submit Fax command) disclosed on Pg. 4 of IBM and pointed out by the Examiner, as well as the rest of IBM, fail to teach, suggest or disclose an "electronic address book" or any equivalent structure, as recited by Claim 19. As disclosed by Applicants' Specification, the "electronic address book" may "include conventional information about each party 10, such as name, business name, address, telephone number, facsimile number, email address, etc." (Applicants' Spec., Pg. 7, lines 26-28). Therefore, unlike IBM, which is merely able to "[s]end a fax to a previously defined destination or fax distribution list" (IBM, Pg. 4), the claimed "electronic address book" stores not only facsimile and telephone numbers, but also email addresses, and physical addresses for sending communications through conventional (i.e., paper) mail. (E.g. Applicants' Spec., Pg. 1, line 28 to Pg. 12, line 3). Furthermore, the Applicants' Specification discloses that the claimed "electronic address book" can be represented by "an address book data structure 60 that includes conventional address book information fields 62 and a business transaction document communication format field 64". (Applicants' Spec., Pg. 7, lines 32-34). IBM lacks the sophistication of "data structures" with such "fields," and in its entirety fails to disclose any equivalent features or structures. Therefore, it is clear that IBM fails to teach, suggest or disclose an "electronic address book" of Claim 19.

Therefore, Applicants respectfully request the withdrawal of this 35 U.S.C. 103(a) rejection, because Claim 19, and dependent Claims 20 and 22-24 are allowable over Naylor in view of IBM.

II. 35 U.S.C. 103(a) Rejection of Claims 19-20 & 22-24: IBM, Henry & Akimoto

"Claims 19-20 and 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over an IBM Corporation product Facsimile Support/400 hereinafter known as IBM in view of Henry US Patent 6,424,426 and Akimoto US Patent 6,775,711." (Pg. 6, Office Action). This rejection is respectfully traversed.

A. IBM

For at least the reasons provided above, IBM fails to teach, suggest or disclose all of the limitations of Claim 19.

B. Henry

Independent Claim 19 recites, in pertinent part:

19. An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

receiving from a client computer an electronic business transaction document ... the electronic business transaction document including address information and a [1] preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the address information and the [2] preferred communication format being automatically retrieved from an electronic address book stored at the client computer, wherein the electronic business transaction document is [3] received by a transaction service server computer communicating with the client computer through a computer network; ...

(emphasis added).

1. "preferred communication format indicator for each ... recipient"

First, Henry fails to teach, suggest or disclose "a preferred communication format indicator for each of the plurality of recipient parties of the business transaction" and "determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction" as recited by Claim 19. The Examiner admits on Page 8, Second Paragraph of the Office Action that: "IBM in view of Henry does not explicitly teach determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction." Therefore, Henry fails to teach, suggest or disclose the above recited limitations of Claim 19.

2. “preferred communication format indicator being automatically retrieved”

Second, Henry fails to teach, suggest or disclose a “preferred communication format indicator being automatically retrieved from an electronic address book” as recited by Claim 19. Henry is directed to a system where users manually fill out a form with email addresses and scan such a form into a fax machine so that it is faxed to a fax server. (See Henry, Abstract and FIG. 3B, 4 and 8A). However, Henry fails to make any mention of a preferred communication format indicator “being automatically retrieved” because in Henry as user must manually “fill in the letterboxes, in normal handwriting, with the final email address(es) it wishes to send to” (Henry, Col. 5:7-10). Also, Henry fails to teach, suggest or disclose an “electronic address book” of Claim 19 because there is no electronic address book “data structure” or equivalent structure that is disclosed by Henry (See Applicants’ Spec., Pg. 7, lines 32-34). Thus, Henry clearly fails to teach, suggest or disclose a “preferred communication format indicator being automatically retrieved from an electronic address book” as recited by Claim 19.

3. “communicating with the client computer through a computer network”

Third, Henry fails to teach, suggest or disclose “wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network” as recited by Claim 19.

Henry is cited by the Examiner in on Page 7, Second Paragraph of the Office Action as: “Henry teaches [an] idea wherein a business document can be sent b[y] a server to a recipient party in their preferred format (fax-to-email and email-to-fax formats).” However, Henry does teach, suggest or disclose “wherein the electronic business transaction document is received by a transaction service server computer communication with the client computer through a computer network” of Claim 19. Rather, Henry discloses technology related to the Internet fax service MongoNet (See Henry, FIG. 4, FIG. 6, and <http://www.mongonet.com>) where users manually fill out a form with email addresses (Henry, Col. 5:3-15) and scan such a form into a fax machine so that it is faxed to a fax server (Henry, Col. 17-26).

In other words, the document in Henry is created by a user that manually fills in the email address on the form, not “automatically retrieved” by a computer program, recited by Claim 19. Most importantly, the document in Henry is sent via facsimile to a fax server (Henry, Col. 16-19, FIG. 2, FIG. 8A), not over “a computer network” in electronic form to a server. Thus, it is respectfully submitted that Henry fails to teach, suggest or disclose “wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network”, as recited by Claim 19.

C. Akimoto

Independent Claim 19 recites, in pertinent part:

19. An electronic business transaction service method for conducting a business transaction over a computer network, comprising:

receiving from a client computer an electronic business transaction document ... the electronic business transaction document including address information and a [1] preferred communication format indicator for each of the plurality of recipient parties of the business transaction, the address information and the [2] preferred communication format being automatically retrieved from an electronic address book stored at the client computer, wherein the electronic business transaction document is received by a transaction service server computer communicating with the client computer through a computer network; ...

(emphasis added).

1. “preferred communication format indicator for each ... recipient”

First, Akimoto fails to teach, suggest or disclose “a preferred communication format indicator for each of the plurality of recipient parties of the business transaction” and “determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction” as recited by Claim 19.

The Examiner cites Akimoto on Page 8, Second Paragraph of the Office Action as supposedly disclosing these above limitations of Claim 19 ("Akimoto, Fig. 8 and disclosure associated with Fig. 8"). However, Applicants respectfully submit that the Examiner is mistaken as to his interpretation of Akimoto. Akimoto still fails to teach, suggest or disclose "determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction" where the communication format received by the recipient party can be a "computer communication format" or a "non-computer communication format". To the contrary, Akimoto is directed to an email communication system having only a single communication format: namely, all communications occur according to a standard "MIME" based "e-mail transfer protocol." (See Akimoto, Col.5:19-54, Col.9:47). There is no teaching or suggestion in Akimoto that communications or transmissions to recipients can occur in any format other than the standard "e-mail transfer protocol" format.

On Page 8, Second Paragraph of the Office Action, the Examiner cites "Akimoto, Fig. 8 and [the] disclosure associated with Fig. 8" in an effort to anticipate the "determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties of the business transaction." However, rather than describe the "preferred communication formats" (e.g. "computer communication format" or "non-computer communication format") of recipient parties, Fig. 8 and the disclosure of Akimoto pertaining to Fig. 8 only discuss how various identification characters can be used to signify that certain processes be performed on an email that is being sent, which is not related to the "preferred communication format" as claimed. (See, e.g. Akimoto, Cols. 7-9). For example, Akimoto "detects the characters 'A' to 'C' after the identification character '@' [in an email address]" to determine that "processing according with these characters is expected." (Akimoto, Col. 8:31-35). "When the identification 'A' is added, signature processing is carried out. When the identification 'B' is added, encryption processing is carried out. When the identification 'C' is added, JPEG conversion is carried out. The JPEG conversion is herein referred to processing for converting the MH file to the JPEG file." (Akimoto, Col. 7:30-35) (describing FIG. 7).

However, as clearly shown at the bottom of the flow chart illustrated in FIG. 8, regardless of which type of content processing has been indicated to be performed, all communications are ultimately transmitted (in the "Transmission Processing" step) in an "e-mail transfer protocol" (Akimoto, Col. 9:47) format where determinations are made (in steps T13 and T14) to ensure that the recipient address is in a "suitable format" for email. (Akimoto, Col. 8:60-65). Therefore, instead of disclosing "determining different communication formats" as recited by Claim 19, Akimoto merely discusses how various identification characters are used to process the content of an email (e.g. signature or encryption processing) before the content is transmitted according to an "e-mail transfer protocol" format (Akimoto, Col. 9:47), regardless of the type of content processing that was performed according to the identification characters. For example, Akimoto teaches that if "it is determined that the specific character is included therein, the server executes processing, which is made to correspond to the identification character, with respect to image data stored in the memory. Thereafter, the server transmits processed image data to the sender in accordance with an e-mail transfer protocol." (Akimoto, Col. 8:42-47) (emphasis added). As such, Akimoto only discloses only one, single computer communication format ("e-mail transfer protocol") that is used for all recipient parties, unlike the multiple and different "communication formats for each of the plurality of recipient parties" as recited by Claim 19.

Therefore, because Akimoto only discloses using one, single and unchanged computer communication format ("e-mail transfer protocol"), Akimoto clearly fails to teach, suggest or disclose "determining at the transaction service server computer a preferred communication format for each of the plurality of recipient parties" where the preferred communication format can be a "computer communication format" (e.g. email) or a "non-computer communication format" (e.g. fax). In addition, the fact that Akimoto uses a single "e-mail transfer protocol" computer communications format for all its communications is similar to the fact that IBM uses a single "CCITT Group 3" (fax) non-computer communications format for all its communications (IBM, Pg. 4-5). As Applicants' Specification discloses, the "expense, time and cooperation required to implement for such an industry-wide standard can be significant" (Applicants' Spec., Pg. 2, lines 3-5). Thus, the present application is advantageously designed to avoid the problem of a single, industry-wide standard practiced by both Akimoto and IBM.

2. "preferred communication format indicator being automatically retrieved"

Second, Akimoto fails to teach, suggest or disclose a "preferred communication format indicator being automatically retrieved from an electronic address book" as recited by Claim 19. Akimoto is directed to an email communication system where all communications are sent according to one format ("e-mail transfer protocol"). Therefore, there is no teaching or suggestion in Akimoto of a "preferred communication format". Furthermore, Akimoto fails to teach, suggest or disclose an "electronic address book" because there is no electronic address book "data structure" or equivalent structure disclosed by Akimoto (See Applicants' Spec., Pg. 7, lines 32-34). Thus, Akimoto clearly fails to teach, suggest or disclose a "preferred communication format indicator being automatically retrieved from an electronic address book" as recited by Claim 19.

D. Claim 22

On Page 9, Fourth Paragraph of the Office Action, the Examiner rejects Claim 22, stating that "IBM in view of Henry, Akimoto and NetGram teaches adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator." Applicants respectfully submit that the Examiner is mistaken in listing "NetGram" in this rejection, because "NetGram" was not mentioned in the rejection shown on Page 6, Last Paragraph of the Office Action, and all the other rejections of Claims 19-20 and 22-24 only involve IBM, Henry or Akimoto. As set forth herein, the combination of IBM, Henry and Akimoto fails to teach, suggest or disclose "wherein adding a recipient party to the electronic business transaction document automatically associates with the recipient party the preferred communication format indicator" for at least the reasons of dependency on allowable Claim 19, and also because all the cited prior art fails to teach, suggest or disclose at least the "preferred communication format" limitation as recited by Claim 22, as proven above in the Remarks.

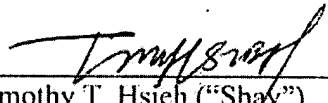
Therefore, Applicants respectfully request the withdrawal of this 35 U.S.C. 103(a) rejection, because Claim 19, and dependent Claims 20 and 22-24 are allowable over IBM in view of Henry and Akimoto.

CONCLUSION

In each case, the pending rejections should be reconsidered in view of the amendments and remarks herein. Applicants believe that this case is in good condition for allowance, and a Notice of Allowance is earnestly solicited. If a telephone or further personal conference would be helpful, the Examiner is invited to call the undersigned at 949-732-6572, who will cooperate in any appropriate manner to advance prosecution. The Commissioner is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to **Deposit Account Number 50-2638**. Please also credit any overpayments to said Deposit Account. Please ensure that Attorney Docket Number 070325-040017 is referred to when charging any payments or credits for this case.

Respectfully submitted,

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